

**REMARKS**

In the Office Action, the Examiner noted that Claims 1 through 8 were pending in the Application. The Examiner rejected all claims. Applicants traverse the rejections below.

**I. Traversal of the Rejection over 35 U.S.C. Section 112**

Claims 1 through 8 were rejected under 35 U.S.C. Section 112, second paragraph, for being indefinite. The Office Action alleged that there are contradictions between the independent claims and some of the dependent claims. Applicants assert that this is not the case, as discussed below.

Claim 2 recites "the stub document includes descriptive parts of the original document so that the stub document can be identified by the user in the document processing system." There is no conflict with independent Claim 1 found in Claim 2. The Office Action alleges Claim 2 claims that "only a portion from the document from the repository is retrieved and inserted into the stub document." This is clearly not the case. Claim 2 states what the stub document includes, not what is retrieved and inserted into the stub. Accordingly, the rejection is inappropriate with respect to Claim 2.

Claim 4 recites "retrieving the stored document from the repository when a user attempts to open the stub document; and inserting content into the stub document from the stored document to restore the original document." The entire stored document is retrieved, and content from the retrieved document is inserted into the stub to restore the stub. There is no conflict relative to Claim 4. Claim 1 recites that the stub maintains

**Serial No. 10/015,302**

**2**

**Docket DE920000113US1**

enough information to retrieve the stored document. In Claim 4, that stored document is actually retrieved, and content from the stored document (Claim 4 does not recite that all content from the retrieved document) is inserted into the stub. More is being read into the claims than they actually state. Accordingly, this rejection is also inappropriate relative to Claim 4.

Claim 7 recites very similar subject matter to Claim 4. Its parent claim, Claim 6, is quite similar to Claim 1, in it recites that the stub document contains "information to enable automatic retrieval of the copied document from the repository." Once again, it is discuss the actual retrieval and restoration process. Accordingly, the rejection is inappropriate relative to Claim 7.

Applicants have demonstrated that there is not conflict between the dependent claims and the independent claims. Accordingly, withdrawal of the rejection under 35 U.S.C. Section 112, second paragraph, is respectfully requested.

The rejection under 35 U.S.C. Section 112, first paragraph, was based on the alleged deficiencies discussed with respect to the rejection under the second paragraph of section 112. As discussed above, the rejection under the second paragraph was based on a misreading of the claims. A stub is maintained which has information for calling the stored copy of the original document. Upon retrieval of the stored copy, content is inserted into the stub to restore the stub. Documents have a certain structure and structural components. For example, headings or fields are maintained. The actual content under such headings or sections is reinserted into the appropriate places. Content does not denote the entire document. For example, Claim 1 recites "stripping content" from the original document. But something (the stub document) remains. Clearly, content does not equal the entire document. Re-inserting content into the stub is consistently discussed. Accordingly, Applicants submit that the Application is in conformance with the

**Serial No. 10/015,302**

**3**

**Docket DE920000113US1**

requirements of 35 USC Section 112, first paragraph, and respectfully request that the rejection be withdrawn.

## II. Traversal of the Rejections over the Cited Art

The Examiner rejected Claims 1 - 8 under 35 U.S.C. 102(c) as being anticipated by U.S. Patent No. 6,505,237 to Beyda et al (Beyda). Applicants traverse these rejections below.

### A. The Present Invention

The present invention provides a technique for handling the off-loading of content from a document to a repository in a document processing system. A document in the system is copied to a remote repository. The document in the system is then stripped down to a stub document containing at least enough information to permit a user to identify the document as well as a link to the copy in the repository. If a user wants to view the document, the copy is retrieved from the repository, and the original document is recreated in the document processing system. This technique is effective in reducing the storage requirements of the document processing system itself by providing enhanced usage of a separate remote storage system.

### B. Differences between the Claims and Beyda

Beyda is directed to the handling and management of files attached to messages. When an electronic message is downloaded by a user from a server, only the attached files

**Serial No. 10/015,302**

**4**

**Docket DE920000113US1**

that meet a prescribed requirement are automatically downloaded. The prescribed requirement can depend on the personal preference of the user. When a user forwards the message, only those files that have been modified are uploaded from the client device to the server.

The Beyda system is clearly different from the present invention. Beyda is directed only to attachments of documents and not downloading automatically certain attachments to electronic messages from a server to a client. When a user tries to download electronic messages from a server, based some predetermined condition, only certain attachments are automatically downloaded. This is not at all like the present invention.

Claim 1 recites "stripping content from the original document in the document processing system to form a stub document, the stub containing at least information to enable automatic retrieval of the stored document from the repository when the stub document is selected by a user". Relative to this subject matter, the Office Action cites Column 4, line 63, which states that "the client devices 14, 16 and 18 may be configured to download only the email message and not the attached file from the local router/server12." There is no discussion of stripping content, only downloading a message and not the attachment, if a client is so configured. (It appears that the argument being made in this rejection contradicts the position taken with respect to rejection under section 112 relative to the term 'content'.) There is no teaching, suggestion or disclosure of a stub which automatically retrieves a stored document upon selection of the stub by a user.

Claim 1 also recites "maintaining the stub document in the document processing system." Relative to this subject matter, the same passage from Column 4 is cited, apparently equating the client to the document processing system. There is no suggestion

**Serial No. 10/015,302**

**5**

**Docket DE920000113US1**

that the client is a document processing system. Is the Office Action arguing that the client is a document processing system and the server is a repository? Is so, this rejection makes little sense relative to the claimed subject matter, as the original document originally resides in the document processing system in Claim 1, at which the content is stripped. In Beyda, no 'stripping' occurs at the client.

Accordingly, Applicants respectfully submit that Beyda does not teach, suggest or disclose the subject matter of independent Claim 1. Independent Claims 6 and 8 were apparently rejected for the same reasons as Claim 1. Based on these arguments, Applicants submit that independent Claims 6 and 8 also patentably distinguish over Beyda. While it follows that the dependent claims also patentably distinguish therefrom, further differences between dependent Claim 4 and independent Claim 8 and Beyda are discussed below.

Claims 4 and 8 recite similar subject matter. Using Claim 4 for exemplary purposes, Claim 4 recites "retrieving the stored document from the repository when the user attempts to open the stub document." Relative to this subject matter, a passage from Column 5, line 44 is cited. This passage has to do with the forwarding of a received email with an attached file, and states that the "receiving party then commands the client device 14 to forward an email message to the sender." This has nothing to do with the subject matter from Claims 4 and 8 cited above. Accordingly, Applicants submit that Claims 4 and 8 further distinguish over Beyda.

### III. Summary

Applicants have presented technical explanations and arguments fully supporting their position that the pending claims contain subject matter which is not taught, suggested


**Serial No. 10/015,302**

**6**

**Docket DE920000113US1**

or disclosed by Beyda, and that the claims are in conformance with the requirement of 35 U.S.C. Section 112. Accordingly, Applicants submit that the present Application is in a condition for Allowance. Reconsideration of the claims and a Notice of Allowance are earnestly solicited.

Respectfully submitted,



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Serial No. 10/015,302

7

Docket DE920000113US1